

for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

Similarly, In Re Regel (188 USPQ 136, CCPA 1975) decided that the question raised under Sec. 103 is whether the prior art taken as a whole would suggest the claimed invention to one of ordinary skill in the art. Accordingly, even if all the elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Simply put, and as stated in In Re Clinton (188 USPQ 365 CCPA 1976), "do the references themselves... suggest doing what appellants have done", such that there is a requirement that the prior art must have made any proposed modification or changes in the prior art obvious to do, rather than obvious to try.

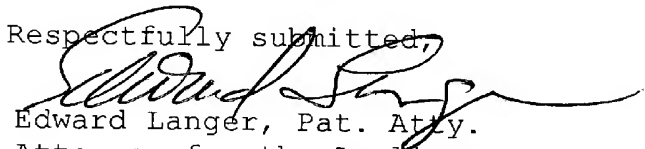
It is respectfully put forward by the Applicant that there is no reason to consider the prior art references, Brown and Riis, either individually or in combination, as rendering the invention obvious, since none of them teach a hydraulically controlled thermostatic mixing valve of the type disclosed in the present invention. The Examiner is relying on speculation and hindsight reconstruction of the references in view of the invention.

As stated in Re Dance, 160 F 3d 1339, 1343 (Fed. Cir. 1998), before prior art references can be combined or modified, there must be some suggestion or motivation found

in the art to make the combination or modification. The only motivation for the modification suggested by the Examiner is that provided by the Applicant's invention. The Applicant is the first to recognize the need for a mixing valve having movable components within a housing which allows full-force fluid streams to pass therethrough precluding clogging of the fluid passages from water particles.

In light of the foregoing remarks, all of the claims in the application as currently amended are deemed to be allowable. Further reconsideration and allowance of the application is respectfully requested at an early date.

Respectfully submitted,



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